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09/815,819	03/23/2001	Wendell Brown	EVOI0009	6685

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EXAMINER

PHAN, JOSEPH T

ART UNIT

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2645

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/815,819	<b>Applicant(s)</b> BROWN ET AL.	
	<b>Examiner</b> Joseph T. Phan	<b>Art Unit</b> 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9, 11-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-9 is/are allowed.
- 6) ☒ Claim(s) 11-24 and 26-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 11-24, 26-29 rejected under 35 U.S.C. 102(e) as being anticipated by Casellini, Patent #6,404,860.**

**Regarding claim 11, Casellini teaches** a method of handling a telephone call for a subscriber, comprising the steps of:

(a) (b) receiving at a call server a call for a subscriber and identifying a first computer-implemented instant messaging system used by the subscriber (203-206 Fig. 4A);

c) sending a first instant message to the subscriber through the instant messaging system, wherein said first instant message includes a first set of options for handling the call, wherein said first set of options are based on a subscriber profile of the subscriber and one or more of said first set of call handling options comprise links to said call server (205-A Fig.4A, Fig.6, and col.4 lines 14-41; *options are only available to user's that have the internet call management service, which is a profile of the user*).

if the subscriber selects one of said first set of call handling options:

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(d) (e) receiving a communication connection from the subscriber, wherein said connection is initiated by the subscriber's selection of a call handling option that comprises a link; and handling the call as specified in said selected call handling option (209-210 Fig.4A and Fig.6); and

wherein the user selects an option to answer the call over the instant messaging service, the controlling step further comprises the steps of:

(e1) if the instant messaging service is communicatively coupled to both a microphone and a speaker at the user's side, establishing an audio connection between the user and the caller(316 Fig.3, 500a Fig.6 and col.5 lines 6-25; options 1, 2, 4, or 5 also establishes an audio connection between the user and the caller); and

(e2) if the instant messaging service is not communicatively coupled to both a microphone and a speaker at the user's side, establishing verbal-textual communication between the caller and the user by enabling speech-to-text and/or text-to-speech software conversion (500b Fig.6 and col.2 lines 51-67; *the IMS service is not communicatively coupled to both a microphone and a speaker when the user chooses not to speak and selects the text-to-speech option*).

Regarding claim 12, Casellini teaches the method of claim 11, further comprising: if the subscriber does not respond to said first instant message within a predetermined period of time, handling the call as specified in a default call handling option (col.4 lines 59-64).

Regarding claim 13, Casellini teaches the method of claim 11, further comprising: identifying the user by an original called number field of the call (col.3 lines 37-44 and

col.4 lines 14-27).

Regarding claim 14, Casellini teaches the method of claim 11, further comprising:  
identifying the caller by a caller identification field of the call; wherein said first instant  
message includes an identifier of the caller (101 Fig.6)

Regarding claim 15, Casellini teaches the method of claim 11, wherein said links  
are hyperlinks to said call server (500a Fig.6)

Regarding claim 16, Casellini teaches the method of claim 11, wherein said  
receiving a call comprises receiving a call forwarded to said call server from a  
subscriber number originally dialed by the caller (500a Fig.6)

Regarding claim 17, Casellini teaches the method of claim 11, further comprising  
retrieving user names of the subscriber for one or more instant messaging systems  
(col.2 lines 60-65 and col.4 lines 14-27).

Regarding claim 18, Casellini teaches the method of claim 11, further comprising  
sending a second instant message to the subscriber through an instant messaging  
system different from said first instant messaging system, wherein said second instant  
message comprises a second set of call handling options (500b Fig.6)

Regarding claim 19, Casellini teaches the method of claim 18, further comprising:  
if the subscriber selects one of said second set of call handling options:  
receiving a return instant message from the subscriber, wherein said return instant  
message includes an identifier of a call handling option selected by the subscriber; and  
handling the call as specified in said selected call handling option (209-210 Fig.4A and  
Fig.6);

Regarding claim 20, Casellini teaches the method of claim 11, wherein said selected call handling option comprises transferring the call and said handling the call comprises: transferring the call from said call server to a telephone number identified by the subscriber (Fig.6).

Regarding claim 21, Casellini teaches the method of claim 11, wherein said selected call handling option comprises playing a message for the caller and said handling the call comprises: playing a message identified by the subscriber for the caller (Fig.6)

Regarding claim 22, Casellini teaches the method of claim 21, further comprising converting said identified message from text to audio prior to said playing (*Fig.6 and col.2 lines 14-41*).

Regarding claim 23, Casellini teaches the method of claim 21, further comprising recording said message prior to said playing (500a Fig.6)

Regarding claim 24, Casellini teaches the method of claim 11, wherein step(e) further comprises the steps of:  
establishing an audio connection between said call server and the subscriber, without further action on the part of the caller; and bridging the call onto said audio connection (500a Fig.6; options 1, 2, 4, or 5 bridges the audio call and does not require further caller action).

Regarding claim 26, Casellini teaches the method of claim 24, wherein said establishing an audio connection comprises establishing an audio connection between said call server and a communication device on which the subscriber received said first

instant message (500a Fig.6; options 1, 2, 4, or 5 establishes an audio connection between call server and a communication device)

Regarding claim 27, Casellini teaches the method of claim 11, wherein said selected call handling option comprises taking a voicemail message from the caller and said handling the call comprises:  
connecting the call to a voice recording module; and recording a message from the caller (500a Fig.6).

Regarding claim 28, Casellini teaches the method of claim 27, wherein the subscriber chooses to screen said voicemail message, the method further comprising establishing an audio connection between said call server and the subscriber; and bridging said audio connection onto said voice recording connection (*101a and 500a Fig.6 and col.4 lines 1-13*).

Regarding claim 29, Casellini teaches a method and a computer readable storage medium storing instructions for controlling a telephone call to an instant messaging user, comprising:

(a,b) receiving at a call server a call directed to the user and identifying an instant messaging service used by the user (203-206 Fig. 4A);

(c) sending an instant message to the user through the instant messaging service to offer the user one or more options for responding to the call, wherein said options are based on a profile of the user (*205-A Fig.4A, Fig.6, and col.4 lines 14-41; options are only available to user's that have the internet call management service, which is a profile of the user*).

(d) if no response is received from the user within a predetermined period of time, controlling the call as specified in a default option (col.4 lines 59-64); and otherwise:  
(e) receiving an option selection from the user; and (f) controlling the call as specified in said selected option (209-210 Fig.4A and Fig.6); and

wherein the user selects an option to answer the call over the instant messaging service, the controlling step further comprises the steps of:

(f1) if the instant messaging service is communicatively coupled to both a microphone and a speaker at the user's side, establishing an audio connection between the user and the caller(316 Fig.3, 500a Fig.6 and col.5 lines 6-25; options 1, 2, 4, or 5 also establishes an audio connection between the user and the caller); and

(f2) if the instant messaging service is not communicatively coupled to both a microphone and a speaker at the user's side, establishing verbal-textual communication between the caller and the user by enabling speech-to-text and/or text-to-speech software conversion (500b Fig.6 and col.2 lines 51-67; the IMS service is not communicatively coupled to both a microphone and a speaker when the user chooses not to speak and selects the text-to-speech option).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



**Claims 30-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Casellini, Patent #6,404,860 in view of Diamant et al, Pub.No. US 2002/0071539 A1.**

Regarding claim 30, Casellini teaches a call control system for handling calls in real-time, comprising:

a call receiver module configured to receive a call directed to a subscriber, a database of subscriber profiles, wherein a profile for a first subscriber includes one or more user names of the first subscriber for one or more instant messaging systems (303-311 Fig.3 and col.4 lines 14-27).

an instant messaging module configured to send an initial instant messaging message to the first subscriber in response to receipt of a call for the first subscriber from a caller, wherein said initial instant messaging message includes a set of options for handling the call (209-210 Fig.4A and Fig.6);

a voicemail module configured to record an incoming message from the caller if the first subscriber selects a voicemail option for handling the call(500a option 2 of fig.6); and a message playback module configured to play an outgoing message for the caller if the first subscriber selects a message playback option for handling the call (500a option 4 of Fig.6)

an audio module configured to establish an audio connection with the first subscriber if the first subscriber selects a call handling option for answering the call over said one or more instant messaging systems, said audio module being further configured to establish an audio connection with the first subscriber if the first subscriber selects a voicemail with screening option for handling the call(500a option 2 of Fig.6 and

col. 4 lines 5-13); and

at least one text-to-speech(500b Fig.6) conversion module which, along with other components of the system, enable verbal-textual communication between the first subscriber and the caller over the instant messaging system being used by the first subscriber (Fig.3, Fig.6; at least one text-to-speech module is used).

Casellini does not explicitly disclose speech-to-text conversion.

Diament explicitly teaches speech-to-text conversion(305 Fig.3 and page 2 para 0017).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include speech-to-text software conversion in Casellini's system. One of ordinary skill in the art would have been motivated to do this as Diament also teaches communication between a telephone user and an instant messaging user and that speech-to-text conversion would be useful for the telephone user to communicate to the IM user.

Regarding claim 31, Casellini in view of Diament teaches the call control system of claim 30, wherein one or more of said call handling options in said initial instant messaging message comprise hyperlinks to the call control system (500a Fig.6)

Regarding claim 32, Casellini in view of Diament teaches the call control system of claim 31, further comprising a network server configured to receive a communication connection from the first subscriber initiated by the first subscriber's selection of one of said hyperlink call handling options (500a Fig.6 and col.5 lines 6-24)

Regarding claim 33, Casellini in view of Diament teaches the call control system

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of claim 30, wherein said instant messaging module is further configured to receive a return instant messaging message from the first subscriber, wherein said return instant messaging message includes a selection of one of said call handling options (Fig.6).

***Allowable Subject Matter***

3. Claims 1-3, 5-9 allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach, among other things, controlling a telephone call to an instant messaging user, wherein if the instant messaging service is not communicatively coupled to a speaker at the user's side, establishing speech-to-text conversion for communication between the caller and user.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the prior art of record, Casellini does not teach offering the user options based on a profile of the user. Examiner respectfully disagrees as these options are only offered to user's that have the Internet call management service. If the user did not have this profile, the options would not be presented to the user.

Furthermore, Applicant also argues that Casellini does not teach the speech-to-text conversion in claims 11 and 29. It is noted that claims 11 and 29 recite "speech-to-text and/or text-to-speech conversion" and therefore the examiner can choose the alternative "or" so that only "text-to-speech" conversion is necessary and not "speech-to-text conversion".

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP

November 23, 2005



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